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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,014	04/01/2004	Raymond B. Ryan	Ryan -P1-04	9572
28710	7590	12/22/2008		
PETER K. TRZYNA, ESQ. P O BOX 7131 CHICAGO, IL 60680			EXAMINER	
			MERCHANT, SHAHID R	
			ART UNIT	PAPER NUMBER
			3692	
			MAIL DATE	DELIVERY MODE
			12/22/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/816,014	<b>Applicant(s)</b> RYAN, RAYMOND B.	
	<b>Examiner</b> SHAHID R. MERCHANT	<b>Art Unit</b> 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 and 45-51 is/are rejected.
- 7) ☒ Claim(s) 43-44 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of the Claims***

1. This action is in response to the amendment filed on September 19, 2008.
  - Claims 1-51 are pending.
  - Claims 1, 9-14, 23-24, 32-36 and 45 have been amended.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-51 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Objections***

3. Claim 43 objected to because of the following informalities: the claim begins with two "A"s. One "a" should be removed. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-20 and 24-42 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what "rules regarding credit...margin stock" Applicant is referring to. Even if one skilled in the art would know what rules are being referenced, it is not clear whether all the rules or some of the rules

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must be complied with. For example, if there are 10 rules that deal with purchase of carrying of margin stock, must all 10 rules be complied with? Further, what are the 10 rules? Can these rules ever change? It would be inappropriate to have the scope of a claim change with time. Since the governments or agencies implementing the rules, regulations or laws meet regularly and have the authority to modify standards, any connection a claim may have to rules, regulations and laws may have varying scope over time. If the rules, regulations or laws change, the disclosure may no longer support the limitation. "Rules regarding credit...margin stock" is indefinite because it can change over time. Applicant is advised to either remove the reference "Rules regarding credit...margin stock" out of the claim or amend the specification to specifically point out what rules are being referenced relative to the date of filing.

6. Claims 9-13, 32-35 and 45 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what "reporting and other compliance requirements of the United States Department of Labor" Applicant is referring to. Even if one skilled in the art would know what "reporting and other compliance requirements" are being referenced, it is not clear whether all the "reporting and other compliance requirements" or some of the "reporting and other compliance requirements" must be complied with. For example, if there are 10 requirements that deal with monitoring the value of collateral, must all 10 requirements be complied with? Further, what are the 10 requirements? Can these requirements ever change? It would be inappropriate to have the scope of a claim change with time. Since the governments

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or agencies implementing the rules, regulations and laws meet regularly and have the authority to modify standards, any connection a claim may have to rules, regulations and laws may have varying scope over time. If the rules, regulations and laws change, the disclosure may no longer support the limitation. “reporting and other compliance requirements of the United States Department of Labor” is indefinite because it can change over time. Applicant is advised to either remove the reference “reporting and other compliance requirements of the United States Department of Labor” out of the claim or amend the specification to specifically point out what requirements are being referenced relative to the date of filing.

7. Regarding claim 1, Applicant states in the preamble a “computer-implemented method of monitoring...” however there is no positively recited step in the body of the claim that recites “monitoring.” The steps recited are “receiving a value...” and “comparing a balance...” Further, the phrase “to monitor sufficiency of the collateral...” is considered to be intended use. Applicant could rewrite the claim by reciting “monitoring sufficiency of the collateral for compliance by comparing a balance of the loan to the value of the collateral” or something similar.

8. Regarding claims 14 and 36, it is unclear how the benefit plan’s financial performance is being calculated. Applicant is advised to recite how the benefit plan’s financial performance is calculated.

***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 1-23 and 46-48 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In *re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

11. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. Thus, claims 1-23 and 46-48 are non-statutory since they may be performed within the human mind.

12. The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. Note the Board of Patent Appeals Informative Opinion Ex parte Langemy, BPAI May 28, 2008.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAHID R. MERCHANT whose telephone number is (571)270-1360. The examiner can normally be reached on First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz P. Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kambiz Abdi/  
Supervisory Patent Examiner, Art Unit 3692

/Shahid R Merchant/  
Examiner, Art Unit 3692